

### **REMARKS**

The present application was filed on October 11, 2000, with claims 1-8, as a continuation-in-part of prior U.S. Patent Application Serial No. 09/606,513, filed June 29, 2000, and U.S. Patent Application 08/864,403, filed May 28, 1997. Claims 1-8 remain pending in the present application. Claims 1 and 2 are the independent claims.

Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,038,257 (hereinafter "Brusewitz").

Claims 2-7 are rejected under §103(a) as being unpatentable over Brusewitz in view of U.S. Patent No. 6,104,752 (hereinafter "Yamagishi").

Claim 8 is rejected under §103(a) as being unpatentable over Brusewitz and Yamagishi in further view of U.S. Patent No. 6,208,691 (hereinafter "Balakrishnan").

In this response, Applicants traverse the §103(a) rejections. Applicants respectfully request reconsideration of the present application in view of the remarks below.

A proper *prima facie* case of obviousness requires that the cited reference, or combination of references, must teach or suggest all the claim limitations, and that there be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejections of claims 1 to 8, in that the cited reference or proposed combinations of references fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for modifying or combining the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a method for simultaneously recording motion and still images. The method includes the steps of:

- a) capturing a motion image sequence and accompanying audio of a scene with a digital video camera adapted to record both low resolution motion image sequences and high resolution still images;
- b) simultaneously capturing a still image sequence having full resolution images and lower frame rate than the motion image sequence, wherein the full resolution images represent images with more pixels than are represented by the low resolution motion image sequences;
- c) compressing the motion image sequence using interframe compression and the accompanying audio and storing the compressed motion image sequences and audio data; and
- d) compressing the still images using intraframe coding and storing the compressed still image data.

Thus, the present invention as set forth in claim 1 requires not only capturing a motion image sequence, but also simultaneously capturing a still image sequence at a lower frame rate than the motion image sequence. It is important to note that the claim calls for capturing a still image sequence simultaneous with the capture of the motion image sequence, rather than capture of a single still image. Such a still image sequence necessarily comprises multiple still images.

In an illustrative embodiment of the invention, a motion/still camera 12 is operable in a combination motion/still mode in which the camera generates a regular sequence of high resolution still image frames and low resolution motion image frames. FIG. 4 of the drawings illustrates such an arrangement, with each pair of high resolution still image frames 102 being separated by four low resolution motion image frames 104. See the specification at, for example, page 5, lines 3-10, and page 10, line 27, to page 11, line 5. Advantageously, such an approach overcomes the significant problems associated with the conventional approach of requiring the user to “press a special button” in order to obtain a single high resolution still image, as described at page 2, lines 6-13, of the specification.

The Examiner argues that all limitations of claim 1 are obvious in view of the Brusewitz reference. Applicants respectfully disagree. With regard to steps (a) and (b) of claim 1, the Examiner relies on FIG. 2 and column 5, lines 32-35, of

Brusewitz. However, the relied-upon portions of Brusewitz fail to teach or suggest capturing a motion image sequence while also simultaneously capturing a still image sequence at a lower frame rate than the motion image sequence. As noted above, such a still image sequence necessarily comprises multiple still images. The relied-upon portions of Brusewitz, by way of contrast, appear to capture only a single still image responsive to a corresponding still image request command from a user. For example, with reference to the flow diagram of FIG. 2 in Brusewitz, step 54 captures only a single high resolution image, responsive to a corresponding still image request command from a user. See Brusewitz at column 5, lines 47-57. Thus, Brusewitz not only fails to teach or suggest the claimed invention, it actively teaches away from it, and suffers from precisely the same problems as the conventional “press a special button” approach described by Applicants at page 2, lines 6-13, of the specification.

This is made further apparent from other teachings in Brusewitz. For example, Brusewitz at column 5, lines 5-20, provides as follows, with emphasis supplied:

By means of the video system configuration set forth in FIG. 1 and as set forth in the co-pending patent application of applicants, conventional video imaging capabilities may be combined with still image management. For example, the video imaging system 6 may operate in normal video mode, displaying a typical 30 frame per second sequence of images at a usual video resolution. However, when the user observes something of interest in the video, the user may request a higher resolution still image in order to study the view in more detail. For example, the viewer of the display 28 in FIG. 1 may want to get a more detailed image of the individual depicted. As discussed in more detail in said co-pending application, the viewer may access the human interface 30 of receiver 22, e.g., through button 36 on the display device 28 or button 40 on the remote device 42, via backchannel 34, to generate a still image.

It is therefore clear that Brusewitz teaches that a user enters a command in order to have camera 10 of system 6 in FIG. 1 capture a single high resolution still image. If a user

subsequently wants the camera 10 to capture a second high resolution still image, another command must be entered. This fails to meet the limitations of claim 1 requiring capture of a still image sequence simultaneous with, but at a lower frame rate, than capture of a motion image sequence.

Inasmuch as claim 1 includes limitations not taught or suggested by the teachings of Brusewitz, the Examiner has failed to establish a *prima facie* case of obviousness for this claim.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for modifying the Brusewitz reference teachings to reach the claimed invention. The claimed arrangement advantageously overcomes problems associated with the conventional approach of requiring a user to enter a separate command each time a high resolution still image is desired. Brusewitz, by teaching such an approach, directly teaches away from the claimed invention, and fails to provide its associated advantages. Accordingly, there is no objective evidence of record which would lead one skilled in the art to modify Brusewitz to reach the claimed invention.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. As noted above, there has been no showing in the present §103(a) rejection of claim 1 of objective evidence of record that would motivate one skilled in the art to modify the Brusewitz reference to produce the particular limitations in question.

It therefore appears that the Examiner in formulating the §103(a) rejection of claim 1 over Brusewitz has undertaken a piecemeal reconstruction of the claimed invention based upon impermissible hindsight, given the benefit of the disclosure provided by Applicants.

Thus, the §103(a) rejection of claim 1 over Brusewitz is believed to be improper, and should be withdrawn.

Independent claim 2 recites, among other elements, an element (b) specifying means for automatically providing a repeating sequence of full resolution image frames regularly interspersed between reduced resolution image frames. The Examiner argues that this limitation is met by the flow diagram in FIG. 2 of Brusewitz. See the Office Action at page 3, last paragraph. However, as Applicants described above, the Brusewitz system clearly requires that the user enter a separate command for each high resolution still image to be captured. This not only fails to meet the claimed means for automatically providing a repeating sequence of full resolution image frames regularly interspersed between reduced resolution image frames, it directly teaches away from such an arrangement. The Yamagishi reference is relied on for allegedly teaching the first and second image buffers, and not for the means element (b) of the claim. See the Office Action at page 4, second paragraph. Applicants note that the Yamagishi reference fails to supplement the deficiencies of Brusewitz as applied to at least the means element (b). Accordingly, the collective teachings of Brusewitz and Yamagishi fail to teach or suggest each and every limitation of claim 2, and a proper *prima facie* case has not been established. Moreover, the statement of motivation for combining Brusewitz and Yamagishi, given at page 4, third paragraph, of the Office Action, appears to be nothing more than a subjective, conclusory statement of the type insufficient to support an obviousness rejection.

Thus, the §103(a) rejection of claim 2 over Brusewitz and Yamagishi is believed to be improper, and should be withdrawn.

Dependent claims 3-8 are believed allowable for at least the reasons identified above with regard to independent claim 2.

With regard to claim 8, the Balakrishnan reference cited by the Examiner fails to supplemental the fundamental deficiencies of the proposed combination of Brusewitz and Yamagishi as applied to independent claim 2. In addition, the Examiner provides only conclusory statements of motivation for combining Brusewitz, Yamagishi and Balakrishnan, and thus fails to establish a proper

*prima facie* case for this additional combination. See page 6, third paragraph of the Office Action.

In view of the foregoing, it is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

As indicated previously, a Notice of Appeal is submitted concurrently herewith.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

***A duplicate copy of this communication is enclosed.***

Respectfully submitted,

A handwritten signature in cursive script, reading "Pamela R Crocker", is written over a horizontal line.

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Enclosure(s): Notice of Appeal